

### **V. REMARKS**

Claims 1, 5, 16-18, 20, 21, 23-20 5, 29 and 33 are rejected under 35 U.S.C. 102 (a and e) as anticipated by Wein (U.S. Patent Application Publication No. 2002/0179242). The rejection is respectfully traversed.

Wein teaches an apparatus for dispensing labels that includes a label assembly having a spool and a label strip. The label strip includes a base layer, an adhesive layer coated onto the base layer and a plurality of label elements discretely coated onto the adhesive layer in a single-file manner such that a blank space is defined between adjacent label elements. The label assembly also includes a dispenser having a spindle for receiving the spool and an applicator configured to enable one of the label elements in combination with a section of the adhesive layer extending from the blank space on one side of the label element to the blank space on the other side of the label element, to be applied to a surface.

Claim 1, as amended, is directed to a mark transfer tool for transferring a transfer mark on a mark transfer tape onto a sheet of paper or the like that includes a hand-held case to be handled by one hand, a pay-out reel of mark transfer tape rotatably installed in the case, a winding reel for collecting the used mark transfer tape rotatably installed in the case, and a transfer head for pressing and transferring the mark transfer tape paid out from the pay-out reel onto the transfer area, being disposed in the leading end portion of the case. Claim 1 recites that the mark transfer tape has a peelable transfer mark layer of multiple pressure-sensitive adhesive transfer marks adhesively held on the surface side of a base tape and that the transfer mark layer is formed by integrally laminating at least a pressure-sensitive adhesive layer of pressure-sensitive adhesive material, and a mark array layer of multiple marks consecutively arranged at specific intervals in the running direction of the base tape. Claim 1 further recites that the pressure-sensitive adhesive layer and the mark array layer being integrally laminated together to form a unitary thin film construction. Additionally, claim 1 recites that the adhesive force PA of the pressure-

sensitive adhesive layer on the transfer area, the adhesive force PC of the transfer mark layer and base tape, and the adhesive force PD of the pressure-sensitive adhesive layer and base tape are set in the relation of  $PA \geq PC \geq PD$ , the transfer mark layer is composed of material cut off by a transfer operation of the transfer head at the time of mark transfer and the elongation rate of the transfer mark layer is set in a visual deformation allowable range of the transfer mark at the time of pressing and transferring of the transfer mark layer by the transfer head.

It is respectfully submitted that the rejection is improper because the applied art fails to teach each element of claim 1 as amended. Specifically, it is respectfully submitted that the applied art fails to teach the pressure-sensitive adhesive layer and the mark array layer are integrally laminated together to form a unitary thin film construction. By contrast, the applied art teaches a label strip having a distinct base layer 64, a distinct adhesive layer 66 and a plurality of label elements 68 with the label elements 68 illustrated in Figures 4B and 4C projecting from the adhesive layer 66 in Figure 4B and projecting from the base layer 64 in Figure 4C. As a result, it is respectfully submitted that claim 1 is allowable over the applied art.

Further, Applicants would to point out to the Examiner that the claimed invention is illustrated in "layers" for example purposes only as discussed in Paragraph 2 on Page 16 of the specification noting that in Paragraph 2 on Page 16, the thickness of the mark transfer tape T is like a thin film and the boundary of layers is not as clear as shown in the drawing.

Claim 21, as amended, is directed to a mark transfer tape provided and used in a mark transfer tool for transferring a transfer mark on a sheet of paper or the like with a transfer mark layer of multiple pressure-sensitive adhesive transfer marks is peelably adhered and held on the surface side of a base tape. Claim 21 recites that the transfer mark layer is formed by integrally laminating at least a pressure-sensitive adhesive layer made of pressure-sensitive adhesive material, and a mark array layer made of multiple marks consecutively arranged at specific intervals in the running direction of the base tape. Claim 21 also recites that the pressure-sensitive adhesive layer and the mark array layer being integrally laminated together to form a unitary thin film construction. Additionally, claim 21 recites that the adhesive force PA of the pressure-sensitive adhesive layer on the transfer area, the adhesive force PC of the transfer mark layer and base tape, and the adhesive force PD of the pressure-sensitive adhesive layer and base tape are set in the relation of  $PA \geq PC \geq PD$ , the transfer mark layer is composed of material cut off by a transfer operation of the transfer head of the mark transfer tool at the time of mark transfer and the elongation rate of the transfer mark layer is set in a visual deformation allowable range of the transfer mark at the time of pressing and transferring of the transfer mark layer by the transfer head.

It is respectfully submitted that the rejection is improper because the applied art fails to teach each element of claim 21 as amended. Specifically, it is respectfully submitted that the applied art fails to teach the pressure-sensitive adhesive layer and the mark array layer are integrally laminated together to form a unitary thin film construction. By contrast, the applied art teaches a label strip having a distinct base layer 64, a distinct adhesive layer 66 and a plurality of label elements 68 with the label elements 68 illustrated in Figures 4B and 4C projecting from the adhesive layer 66 in Figure 4B and projecting from the base layer 64 in Figure 4C. As a result, it is respectfully submitted that claim 21 is allowable over the applied art.

Claims 5 and 16-18 depend from claim 1 and include all of the features of claim 1. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 1 is allowable as well as for the features they recite.

Claims 23-25, 29 and 33 depend from claim 21 and include all of the features of claim 21. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 21 is allowable as well as for the features they recite.

Withdrawal of the rejection is respectfully requested.

Claims 2, 3, 4, 30, 31 and 32 are rejected under 35 U.S.C. 103(a) as unpatentable over Wein in view of von Hofe (U.S. Reissue Patent 28,732). The rejection is respectfully traversed.

Claims 2-4 depend from claim 1 and include all of the features of claim 1. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 1 is allowable as well as for the features they recite.

Claims 30-32 depend from claim 21 and include all of the features of claim 21. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 21 is allowable as well as for the features they recite.

Withdrawal of the rejection is respectfully requested.

Claims 6, 7, 34 and 35 are rejected under 35 U.S.C. 103(a) as unpatentable over Wein in view of Baker (U.S. Patent No. 5,282,631). The rejection is respectfully traversed.

Claims 6 and 7 depend from claim 1 and include all of the features of claim 1. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 1 is allowable as well as for the features they recite.

Claims 34 and 35 depend from claim 21 and include all of the features of claim 21. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 21 is allowable as well as for the features they recite.

Withdrawal of the rejection is respectfully requested.

Claims 9 and 37 are rejected under 35 U.S.C. 103(a) as unpatentable over Wein in view of Doniger (U.S. Patent Application Publication No. 2001/0053644). The rejection is respectfully traversed.

Claim 9 depends from claim 1 and includes all of the features of claim 1. Thus, it is respectfully submitted that claim 9 is allowable at least for the reason claim 1 is allowable as well as for the features it recites.

Claim 37 depends from claim 21 and includes all of the features of claim 21. Thus, it is respectfully submitted that claim 37 is allowable at least for the reason claim 21 is allowable as well as for the features it recites.

Withdrawal of the rejection is respectfully requested.

Claims 10 and 38 are rejected under 35 U.S.C. 103(a) as unpatentable over Wein in view of either Ueda et al. (U.S. Patent No. 5,968,244) or Ochiai et al. (U.S. Patent No. 5,962,137). The rejection is respectfully traversed.

Claim 10 depends from claim 1 and includes all of the features of claim 1. Thus, it is respectfully submitted that claim 10 is allowable at least for the reason claim 1 is allowable as well as for the features it recites.

Claim 38 depends from claim 21 and includes all of the features of claim 21. Thus, it is respectfully submitted that claim 38 is allowable at least for the reason claim 21 is allowable as well as for the features it recites.

Withdrawal of the rejection is respectfully requested.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as unpatentable over Wein in view of Ono et al. (U.S. Patent No. 5,430,904). The rejection is respectfully traversed.

Claims 11 and 12 depend from claim 1 and include all of the features of claim 1. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 1 is allowable as well as for the features they recite.

Withdrawal of the rejection is respectfully requested.

Claims 11-14 are rejected under 35 U.S.C. 103(a) as unpatentable over Wein in view of Narita et al. (U.S. Patent Application Publication No. 2002/0033237). The rejection is respectfully traversed.

Claims 11-14 depend from claim 1 and include all of the features of claim 1. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 1 is allowable as well as for the features they recite.

Withdrawal of the rejection is respectfully requested.

Claim 15 is rejected under 35 U.S.C. 103(a) as unpatentable over Wein in view of Yoo (U.S. Patent No. 5,795,085). The rejection is respectfully traversed.

Claim 15 depends from claim 1 and includes all of the features of claim 1. Thus, it is respectfully submitted that claim 15 is allowable at least for the reason claim 1 is allowable as well as for the features it recites.

Withdrawal of the rejection is respectfully requested.

Claim 19 is rejected under 35 U.S.C. 103(a) as unpatentable over Wein in view of Kozaki (U.S. Patent No. 6,363,990). The rejection is respectfully traversed.

Claim 19 depends from claim 1 and includes all of the features of claim 1. Thus, it is respectfully submitted that claim 19 is allowable at least for the reason claim 1 is allowable as well as for the features it recites.

Withdrawal of the rejection is respectfully requested.

Claim 22 is rejected under 35 U.S.C. 103(a) as unpatentable over Wein in view of Krish et al. (U.S. Patent No. 6,187,432). The rejection is respectfully traversed.

Claim 22 depends from claim 21 and includes all of the features of claim 21. Thus, it is respectfully submitted that claim 22 is allowable at least for the reason claim 21 is allowable as well as for the features it recites.

Withdrawal of the rejection is respectfully requested.

Also, newly-added dependent claims 39 and 40 also include features not included in the applied art.

Further, Applicants assert that there are also reasons other than those set forth above why the pending claims are patentable. Applicants hereby reserve the right to submit those other reasons and to argue for the patentability of claims not explicitly addressed herein in future papers.

In view of the foregoing, reconsideration of the application and allowance of the pending claims are respectfully requested. Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' representative at the telephone number listed below.

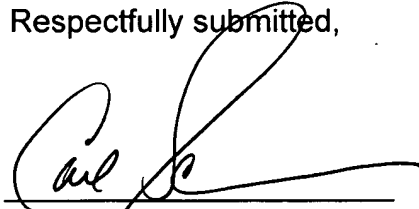
Should additional fees be necessary in connection with the filing of this paper or if a Petition for Extension of Time is required for timely acceptance of the same, the Commissioner is hereby authorized to charge Deposit Account No. 18-0013 for

any such fees and Applicant(s) hereby petition for such extension of time.

Respectfully submitted,

Date: February 27, 2007

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Enclosure(s):       Amendment Transmittal  
                          Petition for Extension of Time (three months)

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